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EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT PAPER NUMBER

2617

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/993,513	Applicant(s) KRAFT ET AL.	
	Examiner Joy K. Contee	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-41 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4,6,8,9,11-19,21,23,24,26-33,35,37,38,40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder et al. ("Schroeder"), U.S. Patent No. 6,405,060, previously used, in view of Balakrishnan et al. (Balakrishnan), US Pat. No. 5,952,942

Regarding claims 1,14 and 28, Schroeder discloses a method of handling the input of words into a text string in a communication terminal, comprising steps of:

inherently recording (i.e., reads on user input is entered in keypad and recorded for look-up) a key stroke sequence inputted for characterizing one of said words (col. 6,lines 31-38);

comparing said key strokes sequence with candidates in a word completion directory in order to find word completion candidates matching said key stroke sequence (col. 6,lines 31-49);

displaying one of said matching word completion candidates in the display for selection by the user (col. 6, lines 31-49); and

adding a word selected by the user to said directory including a plurality of word completion candidates, if the selected word exceeds a first predetermined number of characters, and if this word is not present there already (col. 7, lines 31-55).

Schroeder fails to explicitly disclose wherein the user, when the candidate consists of a text string consisting of a plurality of individual words, selects the first candidate word in the text string by pressing the select-key for a period shorter than a predetermined period of time, and the entire text string by pressing the select-key for a period longer than a predetermined period of time.

In a similar field of endeavor, Balakrishnan discloses pressing a key for a period of time (e.g., holding a key for less than a predetermined time) in order to select a desired "word" (see col. 7, lines 13-16). Balakrishnan also suggests a bigram language model (i.e., two-word combination model) (see col. 7, lines 31-42).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Schroeder to include wherein the user, when the candidate consists of a text string consisting of a plurality of individual words (reads on two-word combination model), selects the first candidate word in the text string by pressing the select-key for a period shorter than a predetermined period of time, and the entire text string by pressing the select-key for a period longer than a predetermined period of time, for the purpose of differentiating key presses (i.e., "pressing and releasing" for cycling through choices

vs. holding a key for a predetermined period for selection of desired word) (see Balakrishnan, col. 6, line 65 to col. 7, line 11).

Regarding claim 2, the combination of Schroeder and Balakrishnan discloses the method according to claim 1, wherein the candidates in the word completion directory comprises a plurality text strings each consisting of a plurality of individual words (see Balakrishnan col. 7, lines 31-42) and derived from text messages stored in the communication terminal (see Schroeder, col. 5, lines 46-55).

Regarding claim 3, The combination of Schroeder and Balakrishnan discloses the method according to claim 2, wherein the user, when the candidate consisting of a text string consisting of a plurality of individual words, selects the candidate word by word (see Balakrishnan col. 7, lines 31-42)

Regarding claim 4, The combination of Schroeder and Balakrishnan discloses the method according to claim 2, wherein the user, when the candidate consisting of a text string consisting of a plurality of individual words, selects all the words in the text string of the candidate (see Balakrishnan col. 7, lines 31-42)

Regarding claim 6, the combination of Schroeder and Balakrishnan discloses the method according to claim 1, wherein the word completion candidates in the word completion directory are searched for matches, when the number of key strokes to be interpreted exceeds a second predetermined number of key strokes (col. 6, lines 56-67 and col. 7, lines 10-13).

Regarding claim 8, the combination of Schroeder and Balakrishnan discloses the method according to claim 1, wherein the first predetermined number of keystrokes is two (col. 6, lines 56-61).

Regarding claim 9, the combination of Schroeder and Balakrishnan discloses a character entry application according to claim 2, respectively, wherein the plurality of text strings each consisting of a plurality of words is searched when a third number of key strokes has been entered for the entire text string (col. 5, lines 61 to col. 6, line 14).

Regarding claim 11, the combination of Schroeder and Balakrishnan discloses the method according to claim 1, wherein the word completion directory contains words being entered by the user by means of a text editor during a plurality of different sessions (col. 5, lines 45-55).

Regarding claim 12, the combination of Schroeder and Balakrishnan discloses the method according to claim 11, wherein the word completion directory contains words being entered by the user in a previously terminated message writing session (col. 5, lines 45-55).

Regarding claim 13, the combination of Schroeder and Balakrishnan discloses the method according to any of the claims 1-12, wherein the key strokes sequence is inputted to a predictive search engine outputting matches matching an ambiguous string of key strokes (col. 5, lines 19-45).

Regarding claim 15, the combination of Schroeder and Balakrishnan discloses a character entry application according to claim 14, and furthermore comprising a predictive search engine to which the recorded key strokes sequence is inputted, and

wherefrom matches matching an ambiguous string of key strokes is outputted in response to the inputted recorded key strokes sequence (col. 4,lines 36-44).

Regarding claim 16, the combination of Schroeder and Balakrishnan discloses a character entry application according to claim 14, wherein the character entry application provides matches matching a string of non-ambiguous keystrokes inputted as the recorded keystrokes sequence (col. 5,lines 19-45).

Regarding claim 17, the combination of Schroeder and Balakrishnan discloses a character entry application according to claim 14, wherein the candidates in the word completion directory comprises a plurality text strings each consisting of a plurality of individual words and derived from text messages stored in the communication terminal (col. 5,lines 46-55).

Regarding claim 18, the combination of Schroeder and Balakrishnan discloses a character entry application according to claim 17 and comprising selection means by means of which the user selects the candidate word by word, when the candidate consisting of a text string consists of a plurality of individual words (col. 5,line 62 to col. 6, line 19).

Regarding claim 19, the combination of Schroeder and Balakrishnan discloses a character entry application according to claim 17, and comprising selection means by means of which the user selects all the word in the text string of the candidate, when the candidate consists of a text string consisting of a plurality of individual words (col. 5,line 62 to col. 6, line 19).

Regarding claim 21, the combination of Schroeder and Balakrishnan discloses a character entry application according to claim 14, wherein the word completion candidates in the word completion directory are searched for matches, when the number of key strokes to be interpreted exceeds a second predetermined number of key strokes (col. 6, lines 56-61).

Regarding claim 23, the combination of Schroeder and Balakrishnan discloses a character entry application according to claim 14, wherein the first predetermined number of keystrokes is two (col. 6, lines 56-61).

Regarding claims 24 and 38, the combination of Schroeder and Balakrishnan discloses a character entry application according to claims 17 and 31, respectively, wherein the plurality of text strings each consisting of a plurality of words is searched when a third number of key strokes has been entered for the entire text string (col. 5, lines 61 to col. 6, line 14).

Regarding claim 26, the combination of Schroeder and Balakrishnan discloses a character entry application according to claim 14, wherein the word completion directory contains words that are entered by the user by means of a text editor during a plurality of different sessions (col. 5, lines 46-55 and col. 7, lines 30-41).

Regarding claim 27, the combination of Schroeder and Balakrishnan discloses a character entry application according to claim 26, wherein the word completion directory contains words being entered by the user in a previously terminated message writing session (col. 5, lines 46-55 and col. 7, lines 30-41).

Regarding claim 29, the combination of Schroeder and Balakrishnan discloses a communication terminal according to claim 28, and furthermore comprising a predictive search engine to which the recorded key strokes sequence is inputted, and wherefrom matches matching an ambiguous string of key strokes is outputted in response to the inputted recorded key strokes sequence (col. 5, lines 19-45).

Regarding claim 30, the combination of Schroeder and Balakrishnan discloses a communication terminal according to claim 28, wherein the character entry application provides matches matching a string of non-ambiguous keystrokes inputted as the recorded keystrokes sequence (col. 5, lines 46-55).

Regarding claim 31, the combination of Schroeder and Balakrishnan discloses a communication terminal according to claim 28, wherein the candidates in the word completion directory comprises a plurality of text strings each consisting of a plurality of individual words and derived from text messages stored in the communication terminal (col. 5, lines 46-55).

Regarding claim 32, the combination of Schroeder and Balakrishnan discloses a communication terminal according to claim 31, and comprising selection means by means of which the user selects the candidate word by word, when the candidate consisting of a text string consists of a plurality of individual words (col. 5, line 62 to col. 6, line 14).

Regarding claim 33, the combination of Schroeder and Balakrishnan discloses a communication terminal according to claim 31, and comprising selection means by means of which the user selects all the word in the text string of the candidate, when the

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candidate consisting of a text string consists of a plurality of individual words (col. 5, line 61- col. 6, line 14).

Regarding claim 35, the combination of Schroeder and Balakrishnan discloses a communication terminal according to claim 28, wherein the word completion candidates in the word completion directory are searched for matches, when the number of key strokes to be interpreted exceeds a second predetermined number of key strokes (col. 6, lines 31-36 and lines 56-61).

Regarding claim 37, the combination of Schroeder and Balakrishnan discloses a communication terminal according to claim 28, wherein the first predetermined number of keystrokes is two (col. 6, lines 56-61).

Regarding claim 40, the combination of Schroeder and Balakrishnan discloses a communication terminal according to claim 28, wherein the word completion directory contains words being entered by the user by means of a text editor during a plurality of different sessions (col. 5, lines 46-55).

Regarding claim 41, the combination of Schroeder and Balakrishnan discloses a communication terminal according to claim 40, wherein the word completion directory contains words being entered by the user in a previously terminated message writing session (col. 5, lines 45-55).

3. Claims 7, 10, 22, 25, 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Schroeder and Balakrishnan.

Regarding claim 7, 10, 22, 25, 36 and 39 Schroeder and Balakrishnan discloses the method according to claim 6, 9, 21, 9, 35 and 9, respectively. Schroeder fails to

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specifically disclose wherein the second (and/or third) predetermined number of keystrokes is four.

However, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Schroeder to include any specific number of characters "N" as user input to determine at least one candidate word from the dictionary tree (col. 6, lines 56-61).

Motivation for doing so would have been for the purpose of achieving a correct match from the direction tree, i.e., a case where multiple words begin with the same 4 letters, e.g., "threat" and "three".

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-41 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4-9 of copending Application No. 09/921,127. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application encompasses the scope of 09/921,127. The differences between the two application are as follows: the instant application describes a text string consisting of a plurality of individual words and '127 describes different characters in a character group and one alphanumeric key which becomes dedicated for scrolling.

Omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before. In re KARLSON (CCPA) 136 USPQ 184 (1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure..

Noguchi et al., US Patent No. 2002/0054135

King et al., US Patent No. 5,953,541

Walker, US Patent No. 6,528,741

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K. Contee whose telephone number is 571.272.7906. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571.272.7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JC


JOY K. CONTEE
PATENT EXAMINER